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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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*Ex parte* SCOTT FATH, PAM MOORE, and JAMES D. EVANS

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Appeal 2008-4372  
Application 10/659,810  
Technology Center 3700

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Decided: August 28, 2008

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Before DEMETRA J. MILLS, LORA M. GREEN, and  
JEFFREY N. FREDMAN, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

**DECISION ON APPEAL**

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-14. We have jurisdiction under 35 U.S.C. § 6(b).

## STATEMENT OF THE CASE

The claims are directed to a ten pack carton blank that is separable into multiple pack retail units of less than ten packs. Claim 1 is representative of the claims on appeal, and reads as follows:

1. A ten pack carton blank for packaging ten packs in two rows with five packs in each row in side-to-side abutting relationship with one another, the blank including front, rear, top, bottom and side wall structure totally enclosing the packs, perforated score lines for separating an assembled ten pack carton into smaller multi-pack retail units, each smaller multi-pack retail unit having at least one open end exposing at least one of the packs therein, and means securing the packs within the smaller multi-pack retail units.

The Examiner relies on the following references:

Swift	192,883	Jul. 10, 1877
Guyer	2,888,132	May 26, 1959
Meyers	3,276,574	Oct. 04, 1966
Focke	4,932, 534	Jun. 12, 1990
Cobler	5,158,178	Oct. 27, 1992

We affirm.

## ISSUE

The Examiner contends that claims 1-14 are obvious over the combination of Guyer, Focke and Swift or Meyers (Ans. 3).

Appellants contend that the Examiner has engaged in impermissible hindsight reconstruction (App. Br.<sup>1</sup> 7).

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<sup>1</sup> All references to the Appeal Brief (App. Br.) are to the Appeal Brief dated November 16, 2007.

Thus, the issue on Appeal is: Has the Examiner engaged in improper hindsight in determining that claims 1-14 are obvious over the combination of Guyer in view of Focke and Swift or Meyers?

#### FINDINGS OF FACT

FF1 Claims 1-14 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Guyer, Focke, and Swift or Meyers (Ans. 3).

FF2 Guyer is relied upon by the Examiner for teaching

a ten pack carton blank (Figure 4) for packaging ten packs in two rows with five packs in each row in side-to-side abutting relationship with one another, the blank including front (10), rear (12), top (11), bottom (13) and side wall structure, perforated score lines (parts of 33) for separating an assembled ten pack carton into smaller multi-pack retail units, each smaller multi-pack retail unit having an open end exposing the packs therein.

(Ans. 3-4.)

FF3 Figure 4 of Guyer is reproduced below.

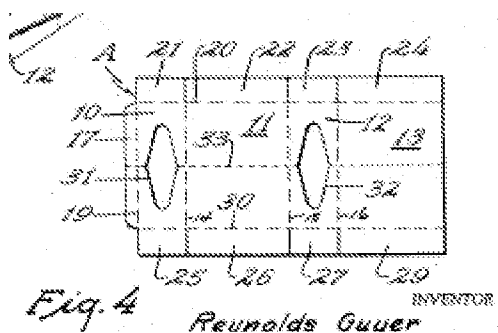


Figure 4 is a diagrammatic view from which the divisible cigarette cartons of Guyer are formed (Guyer col. 1, ll. 15-17; col. 2, ll. 12-13).

FF4 Elongated apertures 31 and 32 extend through the carton walls 10 and 12 (Guyer col. 2, ll. 51-56). The apertures “simplify the removal of the packages of cigarettes from the carton sections.” (Guyer col. 1, ll. 65-72.)

FF5 Swift and Meyers are relied upon for teaching “a divisible carton structure wherein the carton structure is divisible into various combinations.” (Ans. 4.)

FF6 Focke is cited for teaching an adhesive dot to secure each pack within the carton.

#### PRINCIPLES OF LAW

The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) secondary considerations of nonobviousness, if any. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). The Supreme Court has recently emphasized that “the [obviousness] analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 1739. Moreover, an “[e]xpress suggestion to substitute one equivalent for another need not be present to render such substitution obvious.” *In re Fout*, 675 F.2d 297, 301 (CCPA 1982).

## ANALYSIS

The Examiner concludes that to “provide wall structure totally enclosing the packs would require elimination of apertures 31 and 32,” which the Examiner asserts is an “obvious elimination of parts and their function.” (Ans. 4.) The Examiner further concludes that it would have been obvious to the ordinary artisan to employ the adhesive dots of Focke in order to secure the packs with the carton, as suggested by Focke (*id.*).

Appellants argue that “Guyer is clearly different in that the carton fails to totally enclose the packs therein, and also because not one of the packs within the separated smaller units is secured to the carton structure.” (App. Br. 7.) Appellants assert further that the Examiner “brushes aside these limitations” as an obvious elimination of parts and their function, without relying on any suggestion or teaching to that affect in the art (*id.*). Thus, according to Appellants, the Examiner has resorted to improper hindsight using Appellants own disclosure as a blueprint (*id.*).

Appellants’ arguments are not convincing. The elongated notches 31 and 32 are to simplify the removal of the packages of cigarettes from the cigarette section (FF 4), and thus one of ordinary skill would understand their removal would not interfere with ability of the blank in Figure 4 of Guyer to form a divisible cigarette carton. *See In re Kuhle*, 526 F.2d 553, 555 (CCPA 1975) (noting that the deletion of a switch member in an instrument for measuring moisture content of soil as taught by the prior art, as well as other elements of the device, thus deleting their function, “was an obvious expedient.”); *In re Larson*, 340 F.2d 965, 935 (CCPA 1965) (noting

that if an additional feature is not desired, “it would seem a matter of obvious choice to eliminate it and the function it serves.”); *In re Keegan*, 331 F.2d 315, 319 (CCPA 1964) (removing a needle guard deemed obvious if unimpeded removal of sutures more desirable than guarding against accidental displacement of suture ends). As noted by the United States Supreme Court, “[i]f a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740 (2007). Moreover, “[a] person of ordinary skill is also a person of ordinary creativity, not an automaton.” *Id.* at 1742.

As to Appellants argument that Guyer does not teach that the packs within the separated smaller units are secured to the carton structure, the Examiner relied upon Focke to remedy the deficiency, and Appellants have not provided any evidence or argument as to why it would not have been obvious to employ the adhesive dots of Focke in order to secure the packs with the carton, as suggested by Focke.

We therefore conclude that the Examiner has set forth a prima facie case of obviousness as to claim 1. While Appellants argue that the claims are separately patentable (App. Br. 5-6), they only point out differences in what the claims cover. Thus, claims 2-14 stand or fall with claim 1, and the rejection is affirmed as to those claims as well. 37 C.F.R. § 41.37(c)(1)(vii) (noting that merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable).

The Examiner also rejects claims 1, 3, 7, and 9 under 35 U.S.C. § 103(a) as being obvious over the combination of Guyer and Focke. As Appellants merely reiterate their arguments as to the combination of Guyer

in view of Focke and Swift or Meyers (App. Br. 7-8), we affirm this rejection as well.

### CONCLUSIONS OF LAW

We conclude that the Examiner has not engaged in improper hindsight reconstruction, but has set forth a prima facie case that claims 1-14 are obvious over the combination of Guyer, Focke, and Swift or Meyers. We also conclude that the Examiner has set forth a prima facie case that claims 1, 3, 7, and 9 are obvious over the combination of Guyer and Meyers. Therefore, we affirm those rejections.

### ISSUE

The Examiner contends that claims 1-14 are obvious over the combination of Cobler, Focke and Swift or Meyers (Ans. 4).

Appellants contend that the Examiner has engaged in impermissible hindsight reconstruction (App. Br. 7).

Thus, the issue on Appeal is: Has the Examiner engaged in improper hindsight reconstruction in rejecting claims 1-14 as being obvious over the combination of Cobler in view of Focke and Swift or Meyers?

### FINDINGS OF FACT

FF7 Claims 1-14 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Cobler in view of Focke and Swift or Meyers (Ans. 4).

FF8 Cobler is relied upon by the Examiner for teaching



a ten pack carton blank (Figure 7) for packaging ten packs in two rows with five packs in each row in side-to-side abutting relationship with one another, the blank including front (222), rear (224), top (234, 236), bottom (220) and side wall structure, perforated score lines (250, 254, 258) for separating an assembled ten pack carton into smaller multi-pack retail units, each smaller multi-pack retail unit having an open end exposing the packs therein.

(Ans. 4-5.)

FF9 Figure 7 of Cobler is reproduced below.

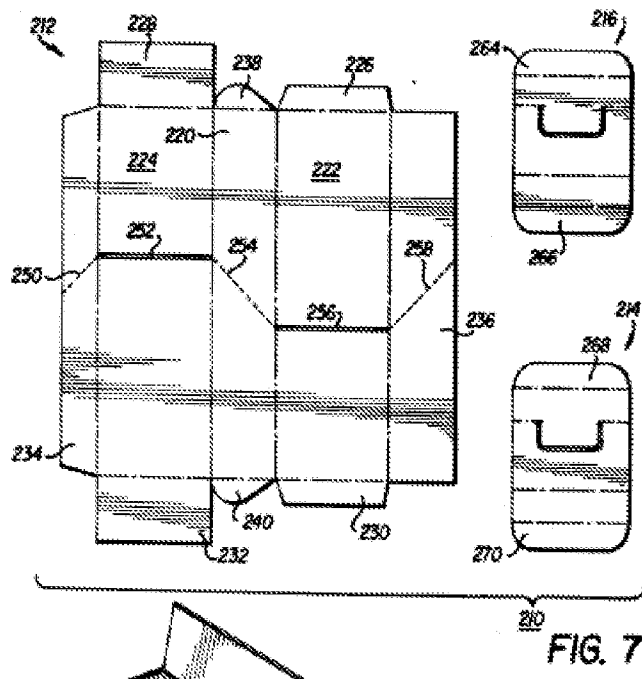


Figure 7 is a top plan view of a blank used to form a package for cigarettes, such that the individual packages can be readily tax stamped (Guyer col. 1, ll. 5-9; col. 3, ll. 12-14).

FF10 Figure 8 of Cobler is reproduced below.

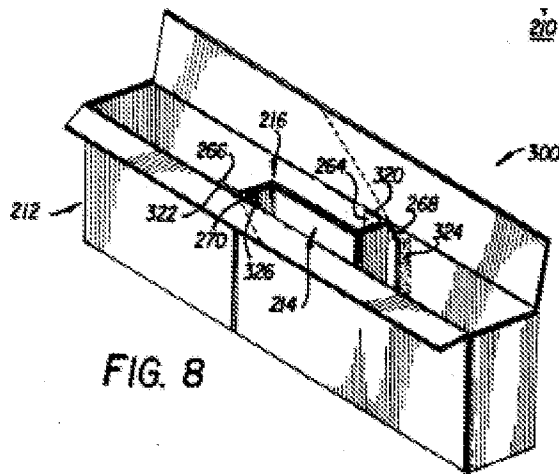


Figure 8 is drawn to the assembled cigarette carton shown in open position (Cobler col. 3, ll. 15-17). In the assembled carton, the blank portions 214 and 216 are positioned within the carton and adhered to the inner side walls (Cobler col. 7, ll. 54-62). The carton assembly can then be divided into two cigarette carton assemblies by tearing at the perforation lines (250, 254, 258) (Cobler col. 7, l. 66-col. 8, l. 4).

FF11 Swift, Meyers, and Focke are relied upon as above (Ans. 7; *see* FF 5 and 6).

## ANALYSIS

The Examiner concludes that to “provide a complete side-by-side abutting relationship of the packs would require elimination of dividers (214 and 216), an obvious elimination of parts and their function.” (Ans. 5.) The Examiner further concludes that it would have been obvious to the ordinary artisan to employ the adhesive dots of Focke in order to secure the packs with the carton, as suggested by Focke (*id.*).

Appellants argue that “Cobler is . . . significantly different in that the smaller retail units do not include at least one open end exposing at least one of the packs therein. Instead, when the carton is ultimately separated into smaller units, each of those units totally surrounds the packs.” (App. Br. 7.) Appellants argue that it would not be obvious to eliminate dividers 214 and 216, as there is no teach or suggestion to do so provided by the art, and that “this reconstruction totally destroys the integrity of the smaller retails [sic] units, and without the flaps 214, 216 the packs would easily fall out of the smaller units” (*Id.*). Thus, according to Appellants, the Examiner has resorted to improper hindsight using Appellants own disclosure as a blueprint (*id.*).

We agree with Appellants. In view of the teaching of Cobler, wherein the ten pack carton assembly may be divided into two five pack carton assemblies (FF 11), if one were to remove the dividers 214 and 216, as noted by Appellants, the integrity of the smaller units would be compromised.

#### CONCLUSIONS OF LAW

We conclude that the Examiner has not set forth a prima facie case that claims 1-14 are obvious over the combination of Cobler, Focke, and Swift or Meyers, and we therefore reverse the rejection.

Appeal 2008-4372  
Application 10/659,810

TIME LIMITS

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

dm

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